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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,144	12/02/2003	David K. Swanson	03-0117 (US01)	5308

41696 7590 01/31/2007  
VISTA IP LAW GROUP LLP  
12930 Saratoga Avenue  
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EXAMINER
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ROANE, AARON F

ART UNIT	PAPER NUMBER
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3739

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/31/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/727,144	<b>Applicant(s)</b> SWANSON ET AL.	
	<b>Examiner</b> Aaron Roane	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 and 38-52 is/are pending in the application.
- 4a) Of the above claim(s) 9, 12, 19, 21, 23, 44 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 11, 13-20, 22, 38-43, 45 and 47-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/22/2006 &amp; 11/13/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 13-16, 18, 22, 38-41, 43, 45, 47 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phan (USPN 6,692,491) in view of Tetzlaff et al. (USPN 6,277,117 B1) and in further view of Hooven (USPN 6,889,694).

Regarding claims 1, 4-6, 8, 13-16, 18, 22, 38-41, 43, 45, 47 and 52, Phan discloses a method and forceps device for cardiac ablation/coagulation procedures, the device comprising first and second clamp members (190 and 192 respectively), first and second support members (194 and 196 respectively) secured to the first and second clamp members, and first and second ablation/coagulation electrode members (first and second means for transmitting coagulation energy) (20 on 194 and 20 on 196) carried by the support device, see col. 16, line 46 through col. 18, line 10 and figures 21-25 in general and figure 25 in particular. The source of ablation/coagulation energy that is connected/coupled to the coagulation electrodes is inherent. Phan fails to explicitly recite that the support members are removably secured to the clamp members and that the support members carry stimulation elements. Tetzlaff et al. disclose vessel sealing

forceps that utilize both mechanical clamping action and electrical energy to affect hemostasis, see col. 1, lines 13-65. Tetzlaff et al. teach providing a clamping forceps device with probes/electrodes (115 and 125) that are attached to the removable base members (111 and 121) in order to provide the clamping forceps device with electrical energy delivery to effect hemostasis of vessels and in order to provide a removable and disposable electrode assembly, see col. 1-7, and particularly col. 1, lines 10-65, and col. 3-6 and figures 1-11. Hooven discloses a forceps device used in ablation of cardiac tissue the device comprising a source of coagulation energy (114) and a coagulation element (120) and teaches providing the device with stimulation electrodes (first and second means for transmitting stimulation energy) (172) adjacent the coagulation element in order to determine if a good/complete conduction block has been formed, see col. 11, line 14 through col. 14, line 48 and col. 15, lines 27 through col. 16, line 6 and figures 33-51 and 66. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Phan, as taught by Tetzlaff et al., to provide a removably securable electrode assembly and support such that the electrode assembly and support is removably securable to the clamp members in order to provide a removable and disposable electrode assembly, and as further taught by Hooven, to provide the ablation/coagulation forceps with additional pacing/stimulation electrodes in order to determine if a good/complete conduction block has been formed.

Regarding claims 2, 3, 48 and 49, Phan in view of Tetzlaff et al. and in further view of Hooven disclose the claimed invention. Tetzlaff et al. disclose a support device with a

mating structure (122) configured to mate with the first clamp member, wherein the mating structure comprises a relatively narrow portion (the base of 122 immediately adjacent 121) and a relatively wide portion (the top or portion of 122 furthest from 121), see col. 6, lines 36-65 and figure 5.

Claims 7, 17 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phan (USPN 6,692,491) in view of Tetzlaff et al. (USPN 6,277,117 B1) and in further view of Hooven (USPN 6,889,694) as applied to claims 6, 16 and 41 above, and further in view of by Bowe et al. (USPN 6,771,996).

Regarding claims 7, 17 and 42, Phan in view of Tetzlaff et al. and in further view of Hooven disclose the claimed invention except for explicitly reciting the coagulation electrode length is greater than the stimulation electrode length. Bowe et al. disclose an ablation and mapping device and teach providing coagulation electrode length(s) that are greater than the mapping/stimulation electrode length(s) in order to provide mapping/stimulation and ablation/coagulation to cardiac tissue, see figures 1-16.

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Phan in view of Tetzlaff et al. and in further view of Hooven, as further taught by Bowe et al., to provide coagulation electrode length(s) that are greater than the mapping/stimulation electrode length(s) in order to provide mapping/stimulation and ablation/coagulation to cardiac tissue.

Claims 10, 20 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phan (USPN 6,692,491) in view of Tetzlaff et al. (USPN 6,277,117 B1) and in further view of Hooven (USPN 6,889,694) as applied to claims 6, 16, 41 and 47 above, and further in view of Maguire et al. (USPN 6,997,925).

Regarding claims 10, 20 and 50, Phan in view of Tetzlaff et al. and in further view of Hooven disclose the claimed invention except for explicitly reciting first and second coagulation element wires connected to the coagulation element. Maguire et al. disclose a device and method of delivering ablative/coagulating energy to cardiac tissue and teach the alternative/equivalence of delivering ablative/coagulating energy via resistive heating, rf current delivery and ultrasound that are "sufficient to ablate tissue when coupled to a suitable excitation source," see col. 17, line 56 through col. 18, line 11. Resistive heaters have a first and second wire connected to them and to the energy source. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Phan in view of Tetzlaff et al. and in further view of Hooven, as further taught by Maguire et al., to provide alternative/equivalence of delivering ablative/coagulating energy via resistive heating instead of rf current delivery "sufficient to ablate tissue when coupled to a suitable excitation source" in order to ablate/coagulate cardiac tissue.

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Claims 11 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phan (USPN 6,692,491) in view of Tetzlaff et al. (USPN 6,277,117 B1) and in further view of Hooven (USPN 6,889,694) as applied to claims 6, 16, 41 and 47 above.

Regarding claims 11 and 51, Phan in view of Tetzlaff et al. and in further view of Hooven disclose the claimed invention except for explicitly reciting the stimulation element is located distally of the coagulation element. However, the placement of the stimulation element proximally, along side of or distally with respect to the coagulation element is well known in the art. Where there is a limited universe of potential options, the selection of any particular option would have been obvious to one of ordinary skill in the art. In re Jones, 412 F.2d 241, 162 USPQ 224 (CCPA 1969). Therefore, at the time of the invention, it would have been an obvious matter of design choice to one of ordinary skill in the art to place the stimulation element distally with respect to the coagulation element.

### ***Response to Arguments***

Applicant's arguments, see section B on page 10 of response, filed 11/15/2006, with respect to the rejection(s) of claim(s) 1-6, 8, 11, 13-16, 18, 22, 38-41, 43 and 45 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Phan (USPN 6,692,491) in view of Tetzlaff et al. (USPN 6,277,117 B1) and in further view of Hooven

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(USPN 6,889,694) (and in further view of Bowe et al. (USPN 6,771,996) for claims 7, 17 and 42, and Maguire et al. (USPN 6,997,925) for claims 10, 20 and 50).

### *Conclusion*

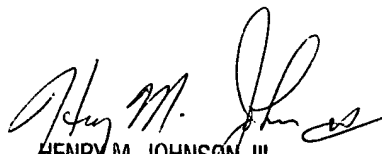
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aaron Roane  
January 24, 2007

A. R.

  
HENRY M. JOHNSON, III  
PRIMARY EXAMINER